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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,259	07/24/2003	Zhong Ding	961_013NP	9582

20874 7590 05/01/2006
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SYRACUSE, NY 13202

EXAMINER

GORDON, BRIAN R

ART UNIT PAPER NUMBER

1743

DATE MAILED: 05/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/626,259	Applicant(s) DING ET AL.	
	Examiner Brian R. Gordon	Art Unit 1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date = _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed January 23, 2006 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-2, 5-6, 8, and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 6 and 9 recite the term "sharp". The term sharp is relative what one person may consider as sharp another may not. The term sharp does not define any specified degree to which one may determine what applicant considers as sharp.

Claims 2 and 6 recite "axial portion/section" it is unclear what elements applicant considers as to be equivalent to these respective elements for the examiner fails to locate the specified terms within the specification nor labeled within the drawings. The entire device is axial. Furthermore it is unclear what diameter applicant is referencing for the device has multiple diameters (inner and outer).

The device also appears to comprise two tip openings (upper and lower) hence it is unclear what tip opening applicant is referencing within claims 1 and 5. Furthermore it is unclear which opening is equivalent to the distal opening of claims 6 and 8.

Claim 9 is stated as a process for reducing fluid oscillation, however there only one step of providing a tip. The method is not clearly defined for simply providing a structure would not accomplish the method as recited. Further steps are required to obtain the goal of the method.

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 9-10 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for achieving the method by aspirating a fluid and latching an air bubble within the tip as explained in detail within paragraphs [0028 and 0029], does not reasonably provide enablement for simply providing the structure and accomplishing the goal of the method. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. There are more steps required in addition to the providing step to achieve the purpose of the method.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-10 rejected under 35 U.S.C. 102(b) as being anticipated by Hughes US 3,449,081.

Hughes discloses a clear, tapered, plastic cap (tip) that includes upper and lower openings and stepped portions therein (see Figures 4 and 6).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 3-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hugs as applied to claim 1-2 and 9 above, and further in view of Treptow et al. US 5,844,686.

In the event applicant asserts Hughes does not disclose a "window" as claimed the examiner has provided this alternative 103 rejection.

Treptow wet disclose an apparatus for pipetting and photometrically evaluating samples which comprise a pipetting means, an integrated photometer and a replaceable pipette tip connected to said pipetting means, said pipette tip being defined as a cell and provided within the optical path of the photometer for photometrically evaluating absorbed samples (abstract).

The pipette tip 4 within the area of the optical path 6, 7 comprises two plane-parallel windows 8, 9 on opposite sides of its wall.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the cap/tip of Hughes et al to incorporate the optical windows as taught by Treptow in order to provide a cap of test kit to allow for "on-the-spot"-analytics of the samples.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Motadel, Arta; Karg, Jeffrey A. et al.; Takeda, Masaaki et al.; Schubert, Frank Ulrich et al.; Rainin, Kenneth et al.; Smith, James C.; Komatsu, Akihiro; Panzer, Armin et al.; Rainin, Kenneth et al.; Schubert; Frank Ulrich et al.; Jacobs; Meritt N. et al.; Taggart; Thomas et al.; Chan; Kwan-Ho; Chen; Hai-Shene; Torti; Victor A. et

al.; Astle; Thomas W.; Smith; Michael W.; Gautsch; Jim; Long; Ernest W.; Garren; Ralph F. et al.; Suovaniemi; Osmo A. et al.; Columbus; Richard L.; and St. Amand; Elmer F. disclose various tip designs.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian R. Gordon whose telephone number is 571-272-1258. The examiner can normally be reached on M-F, with 2nd and 4th F off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'BRG', with a stylized, flowing script.

brg